



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

James Perry et al.

Serial No.: 10/710,458

Filed: July 13, 2004

For: TOOL HOLDER ASSEMBLY

Attorney Docket No.: 81101886 / FMC 1769 PUS

Group Art Unit: 3722

Examiner: Dana Ross

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action mailed April 19, 2006, Applicants request review of the legal and factual basis of the rejections prior to the filing of an appeal brief. A notice of appeal is being filed together with this request for review.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (FIRST CLASS MAIL)

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

July 12, 2006
Date of Deposit

Timothy J. Marsh
Name of Person Signing

Timothy J. Marsh
Signature

Remarks

Claims 1-20 are pending in the application. Claims 6-8, 15 and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,593,258 issued to Matsumoto et al. (hereinafter "Matsumoto"). Claims 6-8, 10 and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,004,382 issued to Yoshino (hereinafter "Yoshino"). Claims 8-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto and Yoshino. Claims 1-5 and 17-20 were withdrawn. Accordingly, claim 6 is the only independent claim that is the subject of the present paper. The invention is believed to be patentable. The rejections are believed to be clearly improper, and based upon clear error.

Independent claim 6 recites a "tool holder assembly for a cutting tool having an end surface and a fluid passage." The tool holder assembly comprises a tool holder and a sealing portion. The tool holder includes "a conduit having a threaded interior section; an adjustment screw having a threaded body section adapted to engage the threaded interior section and a flange section having a larger diameter than the threaded body section, the threaded body and flange sections defining an internal fluid passage disposed coaxially with the conduit; and a counterbore disposed coaxially with the conduit and adapted to receive the cutting tool." The sealing portion is "configured to inhibit fluid leakage between the flange section and the end surface" of the cutting tool. Neither Matsumoto nor Yoshino disclose a sealing portion as claimed.

Applicants have pointed out the deficiency of Matsumoto at page 6 line 17 through page 7 line 7 of Reply Under 37 C.F.R. § 1.111 filed on March 24, 2006. In general, the Applicants note that the elements relied upon by the Examiner to teach the claimed sealing portion (i.e., Matsumoto elements 16, 18, 19 or 32 of Figure 1) simply do not relate to inhibiting fluid leakage. By contrast, the elements relate to preventing vibrations during machining. Accordingly, a *prima facie* case has not been established.

Similarly, Applicants have pointed out the deficiency of Yoshino at page 7 line 19 through page 8 line 7 of Reply Under 37 C.F.R. § 1.111 filed on March 24, 2006. In general, Applicants note that seal bearing 7 does not inhibit fluid leakage between a flange section of an adjustment screw and an end surface of a cutting tool as recited in independent claim 6. Accordingly, a *prima facie* case has not been established.

For the reasons given above, Applicants respectfully request that the panel members review the rejections in this application and find that the application is not in condition for appeal.

Respectfully submitted,

James Perry et al.

By Timothy J. Marsh
Timothy J. Marsh
Reg. No. 56,684
Attorney for Applicant

Date: July 12, 2006

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351